

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

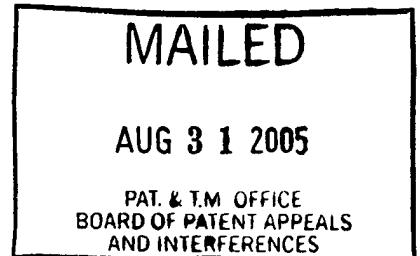
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ERIC HAROLD HENRIKSON and CHINMEI CHEN LEE

Appeal No. 2005-2466  
Application No. 09/877,815

ON BRIEF



Before THOMAS, GROSS, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to replenishment of prepaid accounts during multimedia sessions (specification, page

1). Specifically, the invention includes monitoring the balance of a prepaid account with respect to a predetermined threshold. The monitoring occurs during a communications session that uses the prepaid account. If the balance in the account drops below the threshold during a communications session, the user is notified. After the user is notified, an interactive session is established with the user for adding value to the balance of the prepaid account. The interactive session for adding value is independent of the communications session. In addition, the communications session continues during the interactive session to add value (specification, page 2).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A multimedia communications system that provides for adding value to prepaid accounts comprising:

a first processor that monitors a prepaid account associated with a user terminal to determine whether a balance for the prepaid account is below a predetermined threshold during a first communications session that uses the prepaid account;

a second processor that notifies a user terminal of a status of the balance if the balance is below the predetermined threshold; and

a third processor that initiates an interactive session with the user terminal to add value to the balance for the prepaid account while communications are maintained on the first communications session, where the interactive session is independent of the first communication session.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

McConnell et al. 6,373,930 Apr. 16, 2002  
(McConnell) (filed Sep. 9, 1999)

Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McConnell. Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed March 11, 2005) and the final rejection<sup>1</sup> (mailed May 20, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 4, 2005) and reply brief (filed May 13, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by

---

<sup>1</sup> Incorporated by reference into the examiner's answer (answer, page 3).

the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We turn first to claim 1. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The examiner's position is set forth on pages 2 and 3 of the final rejection. In addition, the examiner asserts (answer, pages 3 and 4) that McConnell's disclosure of:

the SCP may then send a message to the Intelligent Peripheral (IP) instructing it to interject a message into the call or **to collect credit card payment for increase balance**; and in addition, McConnell, (See col. 21, lines 65-67 and col. 22, lines 1-6) by disclosing that the IP can send a message to the MSC directing the MSC to add the IP to the call **without disconnecting the called party**, the IP may then play an announcement to the subscriber and collect additional prepayment and lastly the IP can direct the MSC to release the IP from the conference call **and allow the call to proceed**, has clearly read on the above limitations which Appellant relies on.

The examiner asserts that this disclosure of McConnell meets the claimed "a third processor that initiates an interactive session with the user terminal to add value to the balance for the prepaid account while communications are maintained on the first communications session, where the interactive session is independent of the first communication session."

Appellants' position (brief, page 3) is that "McConnell fails to disclose using an independent interactive session for replenishment of a prepaid account, while communications are maintained for a first communications session using the prepaid account." It is argued (reply brief, pages 2 and 3) that:

McConnell is not referring to two independent sessions, as claimed. More specifically, the options provided by McConnell for prepaid replenishment are accomplished in the one call that is using the prepaid account. For example, McConnell discloses interjecting a message into the call, adding the intelligent Peripheral (IP) to the call, playing an announcement on the call, collecting additional prepayment (credit card) on the conference bridge, releasing the IP from the conference call, and allowing the call to proceed. Nowhere does McConnell suggest or disclose using two independent communications sessions, one for the prepaid call and the other for replenishing the prepaid account. In addition, McConnell does not disclose that communications continue on one session, e.g., call, while replenishment takes place in another session.

From our review of McConnell and the arguments of record, we agree with appellants, for the reasons set forth in the reply brief, that McConnell does not anticipate claim 1. McConnell

discloses (col. 21, lines 32-36) that "the SCP may send a message to the IP instructing the IP to interject a message into the call, to collect credit card payment for increased balance, to terminate the call or to take any other desired action."

McConnell additionally discloses (col. 21, line 65 through col. 22, line 6) that:

In an exemplary embodiment, the inbound looparound port at MSC 110 can be a conference bridge. In that case, the IP can send an IAM message to MSC directing the MSC to add the IP to the call without disconnecting the called party. The IP may then play an announcement to the subscriber and collect additional prepayment. Once the IP completes its tasks, the IP may then send a REL message to the MSC, directing the MSC to release the IP from the conference call, allowing the call to proceed.

From the disclosure of McConnell, we find that interjecting a message into a call to collect credit card payment for increased balance, does not create an interactive session that is independent from the first communication session or call. In addition, the creation of a conference bridge by adding IP to the call without disconnecting the called party meets the claim limitation that the interactive session takes place while communications are maintained, but does not meet the limitation that the interactive session is independent of the first communication session or call. In sum, even though the IP plays the announcement to the subscriber, and not to the party being

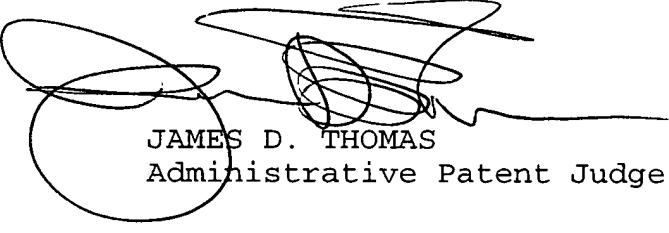
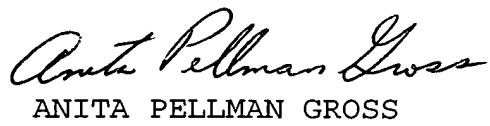
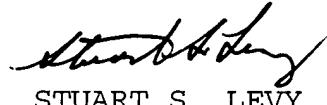
called), we find that because the interjection into the call creates a conference call, the interjected message and payment are part of a conference call and is not independent of the first communication session or call. Accordingly, we are not persuaded by the examiner's assertion (answer, page 4) that because the IP is released from the conference call after payment is made and the call is allowed to proceed, that the interjected message is independent of the call.

As McConnell fails to establish a prima facie case of anticipation of claim 1, the rejection of claim 1 under 35 U.S.C. § 102(e) is reversed. As independent claim 8 similarly recites "initiating an interactive session with the user to add value to the balance for the prepaid account while maintaining communications on the first communications session, where the interactive session is independent of the first communications session," the rejection of claim 8 and claims 2-7 and 9-12, which depend from claims 1 and 8, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-12 under 35 U.S.C. § 102(e) is REVERSED.

REVERSED

  
JAMES D. THOMAS )  
Administrative Patent Judge )  
 )  
  
ANITA PELLMAN GROSS ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
 ) AND  
 ) INTERFERENCES  
 )  
  
STUART S. LEVY )  
Administrative Patent Judge )

Appeal No. 2005-2466  
Application No. 09/877,815

Page 9

JENNER & BLOCK LLP  
ONE IBM PLAZA  
CHICAGO, IL 60611